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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,226	09/18/2000	Ge Li	18692-00002	4280
51414	7590	09/12/2005	EXAMINER	
GOODWIN PROCTER LLP PATENT ADMINISTRATOR EXCHANGE PLACE BOSTON, MA 02109-2881			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/664,226

Applicant(s)

LI ET AL

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-52 are pending in this communication filed 04/01/05 entered as Amendment with filing of RCE.
2. The Supplemental Response filed 06/09/05 has been entered.
3. The drawing objection has been overcome by the drawing replacement sheets for fig.'s 2, 4, and 7 filed 04/01/05 and is hereby withdrawn.
3. The Objection to the Specification has been withdrawn in view of Applicants' convincing arguments.
4. The 35 USC 112, first paragraph rejection for claims 1 and 27 for the introduction of new matter has been considered and overcome by Applicants' amendment.
5. The 35 USC 112, second paragraph for claims 1, 2, 4, 5, 16, 17, 21-24, 27, 28, 30-42, and 47-49 has been overcome by Applicants' amendment to claims 1, 2, 4, 5, 16, 17, 21-24, 27, 28, 30-42, and 47-49 and is hereby withdrawn.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/01/05 has been entered.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 recites the limitation "subset of suppliers", "selected suppliers", and "selected subset of suppliers" in lines 12-17. Claim 27 has a similar problem. There is insufficient antecedent basis for this limitation in the claim.

Throughout the claims "selected suppliers" and "selected supplier" are referenced. There appears to be a lack of agreement in the claim limitations.

Claim Objections

8. Claims 1 and 27 are objected to because of the following informalities: Claim 1, line 5 recites "... , a objective function". This would be better recited "... , an objective function". Claim 27 has a similar problem. Appropriate correction is required.

Drawings

9. The drawings were received on 04/01/05. These drawings are acceptable.

10. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because in fig.'s 6, 8-14, 15A, 15B, 16A, 16B, 17, 19, 20A, 20B, and 21-28 the shaded portion of the drawing figure's are not legible. The shading needs to be removed in order to read the text in the drawing figures. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

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12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-15 and 27-41 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 6,260,024) Shkedy.

As per Claims 1 and 27, Shkedy teaches, A computer-implemented method for determining an optimal award schedule for at least partial satisfaction of a requisition, said method comprising: receiving from a buyer, over a computer network, public buyer constraints representative of said requisition (col. 1, lines 66-col. 2, line 9); receiving from the buyer, over said computer network, an objective function including non-price criteria (col. 2, lines 10-34); transmitting to a set of prospective suppliers, over said computer network, said buyer constraints (col. 5, lines 7-30); receiving from each supplier, over said computer network, a bid responsive to public buyer constraints (col. 5, lines 43-60); and utilizing, by a programmed computer, the objective function to select a subset of suppliers and determine an optimal award schedule for at least partial satisfaction of said requisition utilizing the selected of suppliers (col. 7, lines 27-42, col. 8, lines 60-67, and col. 9, lines 12-34), wherein said optimal award schedule includes information indicative of the manner in which each of said selected subset of suppliers is to at least partially satisfy said requisition (col. 13, line 7-col. 14, line 25).

As per Claims 2 and 28, Shkedy teaches, The method of claim 1, wherein receiving said public buyer constraints from said buyer over said computer network comprises receiving a list of items to be supplied (col. 13, lines 7-29).

As per Claims 3 and 29, Shkedy teaches, The method of claim 2, wherein receiving said list of items comprises receiving a list in which at least one item in said list is a logical item that includes a list of items (col. 13, lines 7-29).

As per Claims 4 and 30, Shkedy teaches, The method of claim 1, wherein receiving said public buyer constraints comprises receiving a constraint selected from the group consisting of a maximum price said buyer is willing to pay for at least partial satisfaction of said requisition; and a non-price constraint required by said buyer for at least partial satisfaction of said requisition (col. 7, lines 20-42 and col. 13, lines 53-59).

As per Claims 5 and 31, Shkedy teaches, The method of claim 4, wherein said non-price constraint is selected from the group consisting of a desired time for at least partial satisfaction of said requisition; a desired quality for at least partial satisfaction of said requisition; and a desired quantity for at least partial satisfaction of said requisition (col. 13, lines 36-61).

As per Claims 6 and 32, Shkedy teaches, The method of claim 1, wherein receiving said bid from each supplier over said computer network comprises receiving a bid including a proposed price for at least partial satisfaction of said requisition (col. 3, lines 39-57).

As per Claims 7 and 33, Shkedy teaches, The method of claim 1, wherein receiving said bid from each supplier over said computer network comprises receiving a

bid including a proposed price having a volume discount dependent on an extent to which said requisition is to be at least partially satisfied.

As per Claims 8 and 34, Shkedy teaches, The method of claim 1, wherein receiving said bid comprises receiving a bid from each supplier over said computer network including a fixed charge independent of an extent to which said requisition is to be at least partially satisfied (col. 10, lines 14-25).

As per Claims 9 and 35, Shkedy teaches, The method of claim 1, wherein receiving said bid from each supplier over said computer network comprises receiving a bundled bid offering to at least partially satisfy, for a bundled price, a requisition for a selection of items from said list of items (col. 15, lines 42-57).

As per Claims 10 and 36, Shkedy teaches, The method of claim 1, further comprising facilitating an exchange of messages between a buyer and a supplier over said computer network (col. 16, lines 7-28).

As per Claims 11 and 37, Shkedy teaches, The method of claim 10, further comprising facilitating the multi-casting of a message sent by said buyer to all suppliers (col. 16, lines 39-61).

As per Claims 12 and 38, Shkedy teaches, The method of claim 1, wherein determining an optimal award schedule comprises considering a performance attribute for a supplier (col. 16, line 62-col. 17, line 22).

As per Claims 13 and 39, Shkedy teaches, The method of claim 12, wherein considering a performance attribute comprises selecting an attribute from the group consisting of the supplier's reputation for prompt delivery, the supplier's reputation for

quality, geographical location of the supplier, the supplier's reputation for support and maintenance, and a user-defined attribute (col. 20, lines 29-49).

As per Claims 14 and 40, Shkedy teaches, The method of claim 12, wherein considering a performance attribute comprises considering a weight supplied by said buyer, said weight being indicative of an extent to which said performance attribute is to be considered in determining said optimal award schedule (col. 25, lines 31-48).

As per Claims 15 and 41, Shkedy teaches, The method of claim 14, wherein considering a performance attribute comprises determining a price penalty on the basis of said weight and incorporating said price penalty in a bid received from said candidate supplier (col. 26, line 46-col. 27, line 8).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 16-26 and 42-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US6, 260,024) Shkedy in view of (US 6,647,373) Carlton-Foss.

As per Claims 16 and 42, Shkedy failed to teach, wherein determining an optimal award schedule comprises applying a requirement that was not known to the suppliers. Carlton-Foss teaches, wherein determining an optimal award schedule comprises applying a private buyer constraint that was not known to the suppliers (col. 12, lines 8-42). It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine an optimal award schedule comprises applying a private buyer constraint that was not known to the suppliers and to modify in Shkedy because such a modification would allow Shkedy to identify the evaluation dimensions along with how heavily it should be weighted in selecting a winning bid.

As per Claims 17 and 43, Shkedy failed to teach, wherein applying the unknown private buyer constraint comprises applying a business rule. Carlton-Foss teaches, wherein applying the unknown requirement comprises applying a business rule (col. 12,

line 43-68 and col. 13, lines 1-4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the unknown private buyer constraint comprises applying a business rule and to modify in Shkedy because such a modification would allow Shkedy to have a bid ranking that merges the ratings into a single rating taking into consideration the number of quantitative dimensions.

As per Claims 18 and 44, Shkedy failed to teach, wherein applying a business rule comprises selecting a business rule from the group consisting of a business rule placing a limit on the number of selected suppliers, a business rule specifying properties of said selected suppliers, a business rule placing a limit on the number of items provided by a selected suppliers, a business rule placing a limit on the number of items provided by a cluster of selected suppliers, and a business rule placing a limit on an extent to which a selected supplier at least partially satisfies said requisition. Carlton-Foss teaches, wherein applying a business rule comprises selecting a business rule from the group consisting of a business rule placing a limit on the number of selected suppliers, a business rule specifying properties of said selected suppliers, a business rule placing a limit on the number of items provided by a selected suppliers, a business rule placing a limit on the number of items provided by a cluster of selected suppliers, and a business rule placing a limit on an extent to which a selected supplier at least partially satisfies said requisition (col. 9, lines 11-43). It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply a business rule comprising selecting a business rule from the group consisting of a business rule placing a limit on the number of selected suppliers, a business rule

specifying properties of said selected suppliers, a business rule placing a limit on the number of items provided by a selected suppliers, a business rule placing a limit on the number of items provided by a cluster of selected suppliers, and a business rule placing a limit on an extent to which a selected supplier at least partially satisfies said requisition and to modify in Shkedy because such a modification would allow Shkedy to terminate the bid if one or more of the conditions are not met.

As per Claims 19 and 45, Shkedy failed to teach, wherein placing a limit comprises selecting a limit from the group consisting of an upper bound and a lower bound. Carlton-Foss teaches, wherein placing a limit comprises selecting a limit from the group consisting of an upper bound and a lower bound (col. 11, lines 10-34).

As per Claims 20 and 46, Shkedy failed to teach, wherein the extent to which a selected supplier satisfies said requisition is measured by a monetary value of said extent. Carlton-Foss teaches, wherein the extent to which a selected supplier satisfies said requisition is measured by a monetary value of said extent (col. 11, lines 35-54).

As per Claims 21 and 47, Shkedy failed to teach, wherein applying unknown requirement comprises rejecting any bundled bid. Carlton-Foss teaches, wherein applying unknown requirement comprises rejecting any bundled bid (col. 12, lines 43-60).

As per Claims 22 and 48, Shkedy and Carlton-Foss failed to teach, wherein applying the unknown requirement comprises manually selecting a supplier for inclusion in said list of selected suppliers, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the unknown requirement

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comprising manually selecting a supplier for inclusion in the list of selected suppliers because such a modification in Carlton-Foss would allow Carlton-Foss to have a list of suppliers that are handpicked for specific products. The manual selection of a supplier for inclusion in a listing of suppliers is well known to be performed by the buyer or purchasing person.

As per Claims 23 and 49, Shkedy and Carlton-Foss failed to teach, wherein applying the unknown requirement further comprises manually specifying an extent to which said manually selected supplier is to at least partially satisfy said requisition, but it would have been obvious to have the manually specifying an extent to which a supplier is at least partially satisfy with the requisition because such a process can be performed either manually or electronically. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the process of specifying an extent to which the selected supplier is to at least partially satisfy the requisition to be performed manually and to modify in Carlton-Foss because such a modification would allow Carlton-Foss to have the ability to place the name of the supplier on paper using a pencil and applying a buyer constraint for the requisition (bid).

As per Claims 24 and 50, Shkedy failed to teach, comprising generating by computer a code indicative of at least one reason for rejecting a losing bid. Carlton-Foss teaches, comprising generating by computer a code indicative of at least one reason for rejecting a losing bid (col. 6, lines 4-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to generate by computer a code indicative of at least one reason for rejecting a losing bid and to modify in Shkedy

because such a modification would allow Shkedy to reject a losing bid if the bid is not submitted by the required date and time.

As per Claims 25 and 51, Shkedy failed to teach, wherein generating said code comprises incorporating into said code information indicative of whether said losing bid was rejected on the basis of a reason selected from a group consisting of an excessive price and an inadequate performance attribute. Carlton-Foss teaches, wherein generating said code comprises incorporating into said code information indicative of whether said losing bid was rejected on the basis of a reason selected from a group consisting of an excessive price and an inadequate performance attribute (col. 6, line 51- col. 7, line 17 and lines 23-31, and col. 8, lines 43-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to generate said code comprises incorporating into said code information indicative of whether said losing bid was rejected on the basis of a reason selected from a group consisting of an excessive price and an inadequate performance attribute and to modify in Shkedy because such a modification would allow Shkedy to reject the bid if the price for the good or service is excessive.

As per Claims 26 and 52, Shkedy failed to teach, further comprising selecting said requisition from the group consisting of a purchase of an item, a purchase of a group of items, a performance of a service, and a performance of a group of services. Carlton-Foss teaches, further comprising selecting said requisition from the group consisting of a purchase of an item, a purchase of a group of items, a performance of a service, and a performance of a group of services (col. 11, line 64- col. 12, line 7 and

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lines 18-21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to selecting said requisition from the group consisting of a purchase of an item, a purchase of a group of items, a performance of a service, and a performance of a group of services and to modify in Shkedy because such a modification would allow Shkedy to have a price, service, warranty, configuration, installation, availability, delivery, and other characteristics for the item or items.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure.

Kinney, Jr. et al (US 6,871,191) disclosed rank bidding in online auctions.


Odom et al (US 6,058,379) disclosed seller specified exchange parameters comprising eight steps.

Inquiries

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
September 6, 2005